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| 10/824,128      | 04/14/2004  | Steven Daryl Smith   | 9210M               | 6439             |

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| EXAMINER |
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MERCIER, MELISSA S

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1615

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/824,128

Applicant(s)

SMITH ET AL.

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt of Applicants Remarks and Amended Claims filed on November 5, 2007 is acknowledged. Claims 1-24 are pending in this application. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US Patent 6,071,503) in view of Morita et al. (US Patent 6,500,439).

Drechsler discloses a transfer resistant cosmetic composition comprising organosiloxane resins and fluid diorganopolysiloxane resins in a volatile carrier. The composition is applied to the lips wherein the carrier volatilizes leaving a thin but durable film resistant to transfer upon contact with objects such as clothing, table wear and foods (column 1, lines 13-20).

The organosiloxane resins disclosed comprise combinations of  $R_3SiO_{1/2}$  "M" units;  $R_2SiO$  "D" units;  $RSiO_{3/2}$  "T" units; and  $SiO_2$  "Q" units, in ratios that satisfy the relationship  $R_nSiO_{(4-n)/2}$  where n is a value between 1.0 and 1.50 and R is a methyl group (column 7, lines 22-27). Preferred ration of M to Q units is 0.7 and the value of n is 1.2 (column 7, lines 35-42).

The fluid diorganopolysiloxane polymer comprises repeating units, wherein said units correspond to the formula  $(R_2SiO)$  where R is a monovalent hydrocarbon radical containing from 1-6 carbons atoms selected from the group consisting of methyl, ethyl, propyl, isopropyl, butyl, isobutyl, t-butyl, amyl, hexyl, vinyl, allyl, cyclohexyl, phenyl, fluoroalkyl and mixtures thereof (column 7, lines 56-63). The diorganopolysiloxane fluids

may be terminated by triorganosilyl groups of the formula  $(R'_3Si)$  where  $R'$  is a radical selected from the group consisting of monovalent hydrocarbons containing from 1-6 carbon atoms, hydroxyl groups, alkoxy groups and mixtures thereof (column 7, line 66 through column 8, line 3). Polydimethylsiloxane is disclosed (column 8, lines 9-11).

The diorganopolysiloxane polymer, preferably has a viscosity greater than 1,000,000 cSt at 25C (column 7, lines 12-20).

The volatile carrier consists of volatile hydrocarbons, volatile silicones and mixtures thereof (column 8, lines 22-27). Isododecane is disclosed (column 8, line 33).

Waxes are disclosed as optional components (column 9, lines 31-34), which the examiner interprets to be a thickener.

Complimentary products may be used in conjunction with the present invention to compliment the composition and improve its aesthetic appeal to the user (column 10, lines 23-25). In the case of lip compositions, a complimentary product may be utilized to enhance the gloss and shine of the lips and provide a lubricious feeling (column 10, lines 30-32). Additionally disclosed, is material that has been shown to be quite useful in formulating complimentary products is polyol polyesters, such as sucrose polyesters, including synthesized molecules derived from sugar and vegetable oil (column 10, lines 40-49).

Drechsler does not disclose the use of a silicone modified fluorinated polymer.

Morita disclose copolymers used in cosmetic compositions. The copolymers comprise a fluorine-containing (meth)acrylate and a silicone macromonomer. The

copolymer is used with a hydrocarbon based solvent or a silicone based solvent, including isododecane (column 10, lines 32-53).

Morita discloses the use of thickeners in the cosmetic composition (column 12, line 46).

It would be within the knowledge of one of ordinary skill in the art to select a combination and amounts of polymers to yield the desired viscosity of the composition. Additionally, since Morita discloses the fluorine modified copolymer is to be used in a cosmetic composition in order to form a film excellent in water resistance, water and oil repellency, feeling when used and safety, it would have been within the skill on the art to use the polymer in the complimentary product since the instant claims indicate the complimentary product is a top coat. Additionally, it would have been obvious to a person of ordinary skill in the art to incorporate the polymers of Morita and Drechsler into the complimentary product to achieve the desired effects of the polymers.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that the claimed polymers are effective ingredients in cosmetic compositions, it would have been obvious to combine the polymers in order to obtain a transfer resistant composition,

since both references teach the polymers are useful for the same purpose. Thus, combining them flows logically from their having been individually taught in prior art.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US Patent 6,071,503) in view of Morita et al. (US Patent 6,500,439) and further in view of Humbert et al (US Patent 4,137,302).

The combined teachings of Drechsler and Morita are discussed above and applied in the same manner.

Drechsler and Morita do not disclose the use of organically modified clays, fumed silica, silgels, alkyl silicone waxes, silicone polyamides, diblock/triblock copolymers, or silsequioxane crosspolymers.

Humbert discloses a cosmetic composition for application to the lips comprising a thickener. Thickeners disclosed include, for example colloidal silicon dioxide, tetra alkyl and/or triaklyl aryl ammonium smectites, organically modified montmorillonite clam, fumed silica, and carboxy vinyl polymers (column 4, lines 32-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the thickeners of Humbert. Both Drechsler and Morita disclose the use of thickeners in the products. The use of the specific thickeners of Humbert to achieve the functional effects of the component is within the knowledge of one of ordinary skill.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., percentages of active agents) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant has argued the amounts of polymers recited in the prior art teach away from the claimed invention. The examiner respectfully disagrees. Applicant's claims do not recite percentages of any of the active agents required. While the claims are read in light of the specification, limitations are not imported in the claims. Furthermore, it is noted that Applicant is pointing out the percentage of silicone modified fluorinated polymers to be 0.01 to 5%. The prior art does in fact teach the percentage of 1-60% as Applicant has acknowledged, therefore, the prior art ranges would encompass the range disclosed by Applicant.

Applicant has not submitted any arguments regarding the Humbert reference.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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